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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/814,097

03/31/2004

Adam Iredell Hayden

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MAGINOT, MOORE & BECK, LLP

CHASE TOWER

111 MONUMENT CIRCLE

SUITE 3250

INDIANAPOLIS, IN 46204

EXAMINER

SCHILLINGER, ANN M

ART UNIT

PAPER NUMBER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/814,097	<b>Applicant(s)</b> HAYDEN ET AL.	
	<b>Examiner</b> ANN SCHILLINGER	<b>Art Unit</b> 3774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 10, 13, 14, 31 and 38-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 10, 13, 14, 31, and 38-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 13, 42-44, 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Burkinshaw (US Pat. No. 6,602,292). Burkinshaw discloses the following of claim 1: a patellar prosthesis comprising: a first subcomponent (34); a boss (80) operably connected to the first subcomponent (see Figure 7); and a second subcomponent (32, 42, 44) movably connected to the first subcomponent with the boss (col. 4, lines 43-61; col. 5, lines 25-46), the second subcomponent comprising, a first side (60), the first side having (i) a channel therein (68), (ii) a boss retaining region (70) with a first configuration, operable to retain the boss within the channel when the boss is inserted into the channel (col. 5, lines 11-13), and (iii) a boss assembly region (66) with a second configuration different from the first, operable to facilitate the insertion of the boss into the channel, by allowing the boss to pass through the boss assembly region for insertion of the boss into the channel. Please note that the examiner is interpreting the term “boss” according to its dictionary definition, which is “a protuberant part or body” (boss. Dictionary.com. Merriam-Webster's Medical Dictionary. Merriam-Webster, Inc. <http://dictionary.reference.com/browse/boss> (accessed: October 20, 2007)).

Burkinshaw discloses the following of claims 2 and 43: the patellar prosthesis, wherein the first subcomponent comprises a base (64) and wherein the second subcomponent comprises an articulating subcomponent (78).

Burkinshaw discloses the following of claims 3 and 44: the patellar prosthesis, wherein: the boss comprises a stem (82) and a head (84) having a width (see Figure 7); the channel has a first side and a second side, the second side spaced apart from the first side by a first distance (see Figure 6); and the boss retaining region comprises a lip, a first section having width and a second section having a width (see element 70 in Figure 5), the first section of the lip located on the first side of the channel and the second section of the lip located on the second side of the channel, the width of the head being greater than the first distance of the channel minus the width of the first section of the lip and minus the width of the second section of the lip (see Figures 5-7).

Burkinshaw discloses the limitations of claims 13 and 46 as shown in Figure 1.

Claims 31, 41, and 48-53 are rejected under 35 U.S.C. 102(b) as being anticipated by Whiteside et al. (US Pat. No. 5,019,104). Whiteside et al. discloses the following of claim 31: a patellar replacement component base comprising: a generally planar bone contacting surface (13) lying in a first plane; a dome shaped, spherical contact surface (15) for contacting a patellar articulating component (12) and located generally opposite the bone contacting surface (see Figure 2); and a boss (16) having a stem (straight portion before element 17) extending from the dome shaped articulating component contact surface along a line, the line of the stem intersecting the bone contacting surface plane at an angle of other than 90 degrees (see Figure 2).

Please note that the examiner is interpreting the term “planar” according to its dictionary definition: “of, relating to, or situated in a plane” (planar. Dictionary.com. *The American Heritage® Dictionary of the English Language, Fourth Edition*. Houghton Mifflin Company, 2004. <http://dictionary.reference.com/browse/planar> (accessed: April 17, 2008)).

Whiteside et al. discloses the following regarding claims 48-53: a patellar replacement component base comprising: a integral body defining generally planar bone contacting surface (13) lying in a first plane, a dome shaped contact surface (15) generally opposite the bone contacting surface; and a stem (16) extending outwardly from the dome shaped contact surface of said body in a direction away from the generally planar bone contacting surface along an axis, the axis of the stem intersecting the bone contacting surface plane at an angle of other than 90 degrees, the stem being integral with said body; and a head (17) extending from the stem. The body, stem, and head are integral with each other (see Figure 2). The components may be made of a polymer (col. 1, line 45 through col. 2, line 6, 25-37).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 14, 45, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burkinshaw. Burkinshaw discloses the use of a spin stop (56), receiving chamber (52), and load region (54). However, the parts of Burkinshaw are in positions that are reversed to those claimed by the Applicant. It would have been obvious to one having ordinary skill in the art at the time

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the invention was made to switch the parts of the first and the second subcomponents, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art.

Claims 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whiteside et al. in view of Burkinshaw. Whiteside et al. discloses the invention substantially as claimed, however, Whiteside et al. does not disclose a spin stop located on the prosthesis. Burkinshaw teaches a patellar prosthesis that uses a spin stop in col. 4, lines 1-53 for the purpose of further securing the prosthesis in its desired configuration. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use spin stops in order to secure the prosthesis in its desired configuration.

### ***Response to Arguments***

The term "axis" used in the amended claims is being interpreted according to its dictionary definition: "a reference line from which distances or angles are measured in a coordinate system" (axis. Dictionary.com. *The American Heritage® Dictionary of the English Language, Fourth Edition*. Houghton Mifflin Company, 2004.

<http://dictionary.reference.com/browse/axis> (accessed: April 17, 2008)). From this definition an axis may be interpreted in the same manner as a "line" where these references points may be placed as needed to meet the claims' limitations. However, a feature such as a central axis will define where the axis must be located to serve as a source for angle measurement.

Applicant's other arguments with respect to claims 1-3, 10, 13, 14, 31, and 38-53 have been considered but are moot in view of the new ground(s) of rejection. The Burkinshaw and the

Whiteside et al. references have been re-interpreted as described above to meet the limitations added in from the amendment.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANN SCHILLINGER whose telephone number is (571)272-6652. The examiner can normally be reached on Mon. thru Fri. 9 a.m. to 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ann Schillinger/  
Examiner, Art Unit 3774

/Corrine M McDermott/  
Supervisory Patent Examiner, Art Unit 3738